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10/568,583	04/17/2007	Masayoshi Son	286489US2PCT	6494
22850 7590 05/05/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHOKSHI, PINKAL R				
ART UNIT		PAPER NUMBER		
2425				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/568,583

Applicant(s)

SON, MASAYOSHI

Examiner

PINKAL CHOKSHI

Art Unit

2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1,6 and 11-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/10/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of **Species II – Group I** in the reply filed on 01/22/2009 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 5 and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claims 5 and 10, it is unclear when claiming "...playback is to be started beyond an insertion start position of advertisement information, said operation control unit performs the playback beyond the insertion start position only after performing the playback of said advertisement information." It is ambiguous what the Applicant means by performs the playback...only after performing the playback of advertisement. Applicant is asked to clarify. For the purpose of examination, it is the Examiner's position that any distance reads on above limitation and such is in accordance with broadest reasonable interpretation, and from the perspective of one having ordinary skill in the art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 2-5 and 7-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over US PG Pub 2002/0191950 to Wang (hereafter referenced as Wang) in view of JP Publication 2001-266482 to Takahashi (hereafter referenced as Takahashi).

Regarding **claim 2**, "a content delivery system that delivers content data including main story information into which advertisement information is inserted" reads on the system where commercial contents are part of video signal that carries television programs (abstract and ¶0001) disclosed by Wang and represented in Figs. 1 and 4.

As to "system comprising: a count adding unit operable to add count data relating to the data length of the advertisement information and a relative data length between a predetermined position of the main story and the insertion position of said advertisement information periodically into said content data" Wang discloses (¶0025 and ¶0066) that the video signal with its matching content classification signal are inputted to an apparatus as represented in Fig. 1 (element 10). Wang further discloses (¶0068 and ¶0069) that the content classification signal, included in video signal, is in terms of marking that indicates the beginning and end locations of all regular content portions (data length

between position of main story) and commercials (data length of ads) and length of the content.

As to “a receiving unit operable to receive the content data as transmitted from said transmitting unit” Wang discloses (§¶0025, ¶0062, and claim 8) that the video signal with content classification information is received at the apparatus as represented in Fig. 5 (element 10).

As to “a playback unit operable to play back said content data” Wang discloses (§¶0022) that the playback device plays video signal as represented in Fig. 1 (element 16).

As to “an operation control unit operable to extract said count data and control the operation of said playback unit in accordance with the description of the count data” Wang discloses (§¶0062) that the decryption device extracts content classification signal from the video signal and provides it to control device. Wang further discloses (§¶0026) that the control device passes this information to playback device plays video signal based on the content classification information received from control device.

Wang meets all the limitations of the claim except “a transmitting unit operable to transmit the content data to which said count data is added in response to a delivery request.” However, Takahashi discloses (§¶0002, ¶0003, ¶0111) that the broadcast head office transmits content stream that includes audio/video data with CM flag and other data as represented in Fig. 18. Therefore, it would have been obvious to one of the ordinary skills in the art at

the time of the invention to modify Wang's system by transmitting content data to an apparatus as taught by Takahashi in order to avoid commercial skip function which skips a commercial part (§0004).

Regarding **claim 3**, "the content delivery system wherein said operation control unit controls said operation in order to inhibit said playback unit from fast-forwarding said advertisement information" Wang discloses (§0028) that based on the content classification signal, the control device controls all the functions of commercial by preventing a user of playback device from fast forwarding a commercial.

Regarding **claim 4**, "the content delivery system wherein said operation control unit inhibits the playback of said main story information in accordance with whether or not there is said content data or count data" Wang discloses (§0028) that the control device controls all the functions of video signals by preventing a playback device from fast forwarding a commercial. However, the Examiner takes official notice that it was well known in the art at the time of the invention to prevent playback of main program when there is no content data. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to not receive content data information to Wang and Takahashi's systems would have yielded predictable result of preventing a playback operation in case of no content data is received in the device.

Regarding **claim 5**, “the content delivery system wherein, when playback is to be started beyond an insertion start position of advertisement information, said operation control unit performs the playback beyond the insertion start position only after performing the playback of said advertisement information” Takahashi discloses (§0095) that when skip range had a commercial part, the skip operation was prohibited. In addition, same motivation is used as to reject claim 1.

Regarding **claim 7**, “a content delivery method that delivers content data including main story information into which advertisement information is inserted” reads on the method where commercial contents are part of video signal that carries television programs (abstract and §0001) disclosed by Wang and represented in Figs. 1 and 4.

As to “method comprising: a first step of adding count data relating to the data length of the advertisement information and a relative data length between a predetermined position of the main story and the insertion position of said advertisement information periodically into said content data” Wang discloses (§0025 and §0066) that the video signal with its matching content classification signal are inputted to an apparatus as represented in Fig. 1 (element 10). Wang further discloses (§0068 and §0069) that the content classification signal, included in video signal, is in terms of marking that indicates the beginning and

end locations of all regular content portions (data length between position of main story) and commercials (data length of ads) and length of the content.

As to “a third step of receiving said content data as transmitted” Wang discloses (§§0025, §0062, and claim 8) that the video signal with content classification information is received at the apparatus as represented in Fig. 5 (element 10).

As to “a fourth step of extracting said count data and controlling an operation relating to the playback of said content data in accordance with the description of the count data” Wang discloses (§0062) that the decryption device extracts content classification signal from the video signal and provides it to control device. Wang further discloses (§0026) that the control device passes this information to playback device plays video signal based on the content classification information received from control device.

Wang meets all the limitations of the claim except “a second step of transmitting the content data to which said count data is added in response to a delivery request.” However, Takahashi discloses (§§0002, §0003, §0111) that the broadcast head office transmits content stream that includes audio/video data with CM flag and other data as represented in Fig. 18. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Wang’s system by transmitting content data to an apparatus as taught by Takahashi in order to avoid commercial skip function which skips a commercial part (§0004).

Regarding **claim 8**, "the content delivery method wherein, in said fourth step, said operation is controlled in order to inhibit fast-forwarding said advertisement information" Wang discloses (§0028) that based on the content classification signal, the control device controls all the functions of commercial by preventing a user of playback device from fast forwarding a commercial.

Regarding **claim 9**, "the content delivery method wherein, in said fourth step, the playback of said main story information is inhibited in accordance with whether or not there is said content data or count data" Wang discloses (§0028) that the control device controls all the functions of video signals by preventing a playback device from fast forwarding a commercial. However, the Examiner takes official notice that it was well known in the art at the time of the invention to prevent playback of main program when there is no content data. Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to not receive content data information to Wang and Takahashi's systems would have yielded predictable result of preventing a playback operation in case of no content data is received in the device.

Regarding **claim 10**, "the content delivery method wherein, in said fourth step, when playback is to be started beyond an insertion start position of advertisement information, the playback beyond the insertion start position is

performed only after performing the playback of said advertisement information” Takahashi discloses (§10095) that when skip range had a commercial part, the skip operation was prohibited. In addition, same motivation is used as to reject claim 1.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US PG Pub 2004/0015984 to Yamamoto discloses an information processing device which enhances efficiency of watching commercial.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PINKAL CHOKSHI whose telephone number is (571) 270-3317. The examiner can normally be reached on Monday-Friday 8 - 5 pm (Alt. Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pinkal Chokshi/
Examiner, Art Unit 2425

/Brian T. Pendleton/
Supervisory Patent Examiner, Art Unit 2425